> (A) The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent. When considering whether the invention defined in a claim of an application is an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art.

The Examiner has not demonstrated any of the above with respect to US Patent No. 6,486,185 and copending Application Nos. 09/899,550, 09/190,931, 10/076,140 and 10/157,007. Instead, she has repeatedly used the same language for each copending application, stating "[a]lthough the conflicting claims are not identical, the claims are not patentably distinct . . . because they embrace the compounds, compositions and method of use of the instant invention." Applicants contend that this non-specific language is not sufficient to establish a case of obviousness.

Furthermore, with respect to US Patent No. 6,486,185, applicants contend that nothing within the language of the claims motivates one to arrive at the present invention, rather than any of the various other numerous permutations of the claims of US Patent No. 6,486,185. Thus, without demonstration of how the claims supply the requisite motivation, this rejection is improper and should be withdrawn.

Applicants also traverse the rejection from the Examiner over co-pending Application No. 09/899,550. The compounds of this copending application require an imidazoline moiety to be attached to the oxindole, whereas in the pending claims of the present application, A can be N, O or S and B can be C or N. Thus, the claimed imidazoline moiety in co-pending Application No. 09/899,550 fails to render the presently claimed structure obvious because the imidazoline moiety does not teach all of the elements of or motivate one to arrive at the presently claimed invention.

Applicants traverse the rejections from the Examiner over co-pending Application No. 09/190,931. The compounds of this copending application require a phenyl piperidine moiety in lieu of the pyrrole of the present invention. The claims of copending Application No. 09/190,931 teach structurally dissimilar compounds without suggesting the present invention. Therefore there is no teaching or motive to arrive at the present invention.

With respect to the rejection over co-pending Application No. 10/076,140, applicants traverse this rejection. The compounds of co-pending Application No. 10/076,140 all require a 2-hydroxy propyl amide at the 3 position of the pyrrole, which is not a requirement of the present invention. As this structure requirement is different from the pyrrole of the present invention, the compounds claimed in co-pending Application No. 10/076,140 cannot render the present application obvious.

With respect to the rejection from the Examiner over co-pending Application No. 10/157,007, applicants also traverse this rejection. The claims under examination in co-pending Application No. 10/157,007 are mostly phenylmethanesulfonyl compounds. Moreover, all the compounds of co-pending Application No. 10/157,007 require a phenyl-alkyl-$S(O)_n$- moiety attached at certain positions of the oxindole. The present invention does not require this moiety and therefore cannot be rendered obvious by the compounds of the claims of co-pending Application No. 10/157,007.

In view of the above arguments, applicants submit that all of the double patenting obviousness rejections are improper and should be withdrawn and that this application is in condition for allowance. Early notice to that effect is earnestly solicited. The Examiner is invited to telephone the undersigned at the number listed below if the Examiner believes this would be helpful in advancing the application to issue.

Respectfully submitted,

April 22, 2003
Date

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Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge Deposit Account No. 19-0741 for any such fees; and applicant(s) hereby petition for any needed extension of time.